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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,605	03/30/2004	Gunther Schiller	SCHILLER - 1	4379
25889	7590	10/19/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			DANIELS, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,605

Applicant(s)

SCHILLER, GUNTHER

Examiner

Matthew J. Daniels

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to an apparatus, classified in class 425, subclass 63.
 - II. Claims 15-20, drawn to methods, classified in class 264, subclass 34.
2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used in another and materially different process, such as application of a polymeric sheet to the interior of lead pipe.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mrs. Richter on 12 October 2005, a provisional election was made **with** traverse to prosecute the invention of Group II, claims 15-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claim 15** is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/813,585 in view of Haddy (USPN 4690631). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

The language of Claim 15 of the instant application and Claim 14 of the '585 application appears to be the same except for the presence of a turntable in the instant application. The '585 lacks a turntable. However, turntables are known and obvious in the art of forming concrete pipes, and this aspect is taught by Haddy (Fig. 1, Item 16). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method

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of Haddy into the '585 application in order to provide a safe and efficient method for moving concrete pipes between stations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. **Claim 18** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed step of reversibly reducing the outside diameter of the first compacting tool does not, by itself, materially affect the claimed process. It is separate from and prior to the step of filling the mold mantle with the second material. Therefore, this limitation does not materially affect the claimed method because it is interpreted to be only a positioning step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 15, 16, 19, 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Haddy (USPN 4690631). In Claim 15, the “means” language of the claim is not interpreted as having invoked 35 USC 112, sixth paragraph, because

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part (A) of the three-prong analysis set forth in MPEP 2181(I) is not met. **As to Claim 15**, Ottmann teaches a method for the production of a multi-layer concrete pipe, comprising the following steps:

pivoting a mold mantle, which stands essentially vertically, into a stand (Fig. 1, Items 10 and 12);

filling the mold mantle with first concrete mixture by means of a first charging system (Fig. 1, Item 22);

distributing and compacting the concrete mixture in the mold mantle by means of a rotating and vertically displaceable compacting tool (Fig. 1, Items 20, 18, 16, 24);

pivoting the mold mantle, which stands essentially vertically, out of the stand and removing the concrete pipe from the mold (inherent in Ottmann's method);

wherein before the concrete pipe is removed from the mold, a second concrete mixture filled into the mold mantle, said mold mantle standing essentially vertically, and a diameter of the compacting tool for distributing and compacting the second concrete mixture is reversibly reduced (3:22-45).

Ottmann is silent to a turntable. However, this aspect is known in the art and is taught by Haddy (Fig. 1, Item 16). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Haddy into that of Ottmann in order to provide a more efficient and safer method for moving the filled mold between stations than Ottmann's overhead crane (Fig. 4, Item 50). **As to Claim 16**, in the method of Ottmann, before the second concrete mixture is filled into the mold mantle and distributed, the first compacting tool (Fig. 1, Items 16 and 18) is exchanged for a second compacting tool (Fig. 4, Item 28).

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Although silent to a “quick-change” device, the Examiner’s position is that this is an apparatus limitation which does not materially affect the claimed method for producing a multilayer pipe (Claim 15). Additionally, Ottmann’s clips and lift are interpreted to be a quick-change method for switching tools (Fig. 3, Item 48 and Fig. 4, Item 50). **As to Claim 19**, in Ottmann’s method the mold mantle is moved from a first to second stand (See Figs. 1-4). Changing stands by pivoting would have been prima facie obvious over Haddy’s teaching of a turntable, because moving the filled mold by Haddy’s method would have been obviously preferable to Ottmann’s crane. **As to Claim 20**, Ottmann teaches movement from a first stand to a second stand before curing of the first layer (3:40-45). The particular configurations of the turntables in this case does not materially affect the method of making. However, Haddy teaches that such turntables are known, and it would have been obvious to move pipes using such turntables to the various processing stations of Ottmann.

9. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Haddy (USPN 4690631), and further in view of Kern (USPN 5051223). Ottman and Haddy teach the subject matter of Claim 16 above under 35 USC 103(a). **As to Claim 17**, Ottmann further teaches applying a first and second concrete mixtures to achieve an excellent internal finish (3:22-45). Ottmann and Haddy are silent to the claimed configuration. However, Kern teaches applying a first concrete (Fig. 1, dotted portion) and second mixture (See Fig. 1, Items 10, 12, 11, and 13) at essentially the same time from first and second charging systems (inherent in Kern’s method), the second being applied through the shaft on which the compacting tools are mounted (See Fig. 1, Items 10, 12, 11, and 13). It would have been prima

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facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Kern into that of Ottmann and Haddy in order to save time by avoiding multiple passes for finishing and subsequent sealing.

10. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ottmann (USPN 4041118) in view of Haddy (USPN 4690631), and further in view of Gourlie (USPN 3262175). Ottmann and Haddy teach the subject matter of Claim 15 above under 35 USC 103(a). As to **Claim 18**, Ottmann and Haddy are silent to the outside diameter of the first compacting tool being reversibly reduced. However, this aspect of the invention would have been prima facie obvious in view of Gourlie, who teaches a first compacting tool having trowels mounted on hydraulics to reversibly expand or reduce the size of the first compacting tool (Figs. 3 and 4). Using Gourlie's hydraulic cylinders, it would have been obvious to reversibly expand or contract the compacting tool.

In particular, after the completion of the compaction of the first layer, it would have been obvious to reduce the size of the compacting tool to either accommodate the next layer or provide easier removal from the compacted form.

Additionally, the claim is drawn to the diameter being reversibly reduced at any point prior to the second concrete mixture being applied. Such a reduction in diameter would have been obvious prior to application of the first concrete layer in order to produce subsequent pipes having a smaller diameter or thicker walls.

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Gourlie into that of Ottmann and Haddy in order to

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accommodate the second layer of material or produce pipes having a smaller diameter or thicker walls.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Thursday, 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJD 10/13/05

MJD

A handwritten signature in black ink, appearing to read 'Michael P. Colaianni', with a horizontal line extending from the end of the signature.

MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER